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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,790	11/12/2003	Allen W. Van Noy	ADI-098	7808
51414	7590	11/23/2005		
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			EXAMINER KAVANAUGH, JOHN T	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,790

Applicant(s)

VAN NOY ET AL.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 18-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-6-05, 8-12-05, 7-05-05, 5-5-04, 2-27-04, 11-12-03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of species III (figures 5-6) in the reply filed on Nov. 7, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Nov. 7, 2005.

### *Claim Rejections - 35 USC § 112*

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 5 define the guide surface with respect to the movement of the shoe relative to the ground and the passing airflow and therefore are indefinite inasmuch as the angle with respect to the ground is not known and the direction of the air flow is not known.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-14,18-20,22-28,30-32,34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by US 1717183 (Brenner).

Benner teaches a shoe having a ventilation system (the shoe will inherently provide ventilation inasmuch as it has a plurality of openings in the shoe upper) as claimed including at least one opening in the upper, a beam (10), and a plurality of parallel guiding surface/ vanes (11) extending over the openings, the guiding surface appear to be in the angles as claimed. The openings between the vanes (11) allow for air to enter and exit. The vanes (11) inherently function as a guiding surface.

6. Claims 1-14,18-20,22-28,30-32,34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2082309 (Turiansky).

Turiansky teaches a shoe having a ventilation system as claimed including at least one opening in the upper, a beam (cross strips 2), and a plurality of parallel guiding surface/ vanes

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(outer strips 1) extending over the openings, the guiding surface appear to be in the angles as claimed. The openings between the vanes (1) allow for air to enter and exit. The vanes (1) inherently function as a guiding surface and help to direct air into the openings.

7. Claims 1-13,18-20,22-28,30-32,34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 9208875.9 (Hsing).

Hsing teaches a shoe having a ventilation system as claimed including at least one opening in the upper and a plurality of parallel guiding surface/ vanes (see figure 1 and page 6 of the translation) extending over the openings, the guiding surface appear to be in the angles as claimed. The openings allow for air to enter and exit.

8. Claims 1-13,18-35 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6871420 (Shikahashvili).

Shikahashvili teaches a shoe having structure as claimed including at least one opening in the upper and at least one in the sole, and a plurality of parallel guiding surface/ vanes (fins 3) extending over the openings, the guiding surface appear to be in the angles as claimed. The vanes (1) inherently function as a guiding surface and help to direct air into the openings and therefore inherently is a ventilation system. Regarding claim 33, the vane (fin 3) is triangular shaped, see figure 2 and 4C.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the following: Shikhashvili '420 or Hsing or Turiansky '309 or Brenner '456.

To the extent that the angles fall out of the range as claimed, it would be an obvious design choice to orientate the guiding surfaces with the angles as claimed inasmuch as a plurality of different angles appear to be suitable and inasmuch as applicant doesn't teach that this provide any new or unexpected results.

11. Claims 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references Hsing or Turiansky '309 or Brenner '456) as applied to claims 20 and 28 above, and further in view of US 1974456 (Goldzweig).

Goldzweig teaches provide a shoe sole with centrally located outlets (8). It would have been obvious to provide the shoe as taught above with the sole having centrally located outlets, as taught by Goldzweig, to provide further ventilation.

### ***Conclusion***

12. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”


--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
November 21, 2005